REMARKS

The only issues outstanding in the Final Rejection mailed April 15, 2009, are the rejections under 35 U.S.C. 112, first paragraph. Reconsideration of these rejections, in view of the following discussion, is respectfully requested.

Claims 1-11, 13 and 15 have been rejected under 35 U.S.C. 112, first paragraph. It is argued that, although the specification enables making salts of the claimed compounds, it does not provide enablement for "prodrugs" thereof. Applicants respectfully disagree. The formation of prodrugs, i.e., compounds which convert to the active compound after administration, are well known to pharmaceutical chemists skilled in the art. The objection raised in the Office Action, in fact, appears to be the breadth of the term "prodrug", but it is submitted that this is insufficient reason to support an enablement rejection. The first paragraph of 35 U.S.C §112 requires only *objective* enablement. Where a specification teaches the manner and process of making and using the invention, the specification *must* be taken as sufficient under §112, unless there is reason to doubt the truth of these statements. See *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971).

On the one hand, it is submitted that the Examiner has not provided any such reasons or evidence to doubt the assertion of enablement in the specification and, thus, the further steps of the analysis as set forth in *Marzocchi* are not reached. As clearly stated in *Marzocchi*, mere *breadth* of the claims does not, without more, result in non-enablement:

> Turning specifically to the objections noted by the Board as indicated above, it appears that these comments indicate nothing more than a concern over the *breadth* of the disputed term. If we are correct, then the relevance of this concern escapes us. It has never been contended that Applicants, when they included the disputed terms in their specification, intended only to indicate a single compound. Accepting, therefore, that the term is a generic one, its recitation must be taken as an assertion by Applicants that all of the 'considerable number of compounds' which are included in

> the generic term would, as a class, be operative to produce the asserted enhancement of adhesion characteristics. The only relevant concern of the patent office under these circumstances should be over the *truth* of any such assertion. The first paragraph of §112 requires nothing more than *objective enablement*. How such a teaching is set forth, either by the use of illustrative examples or by broad term analogy, it is of no importance.

Marzocchi, *supra*. (Emphasis in original.) Thus, the concern expressed at page 3 of the Office Action, apparently that the term is broad, does not provide the reasons or evidence necessary by *Marzocchi* to pass beyond the necessity merely for objective enablement.

The discussion of *In re Wands*, taking up a substantial amount of the Office Action, does *not* provide the necessary reasons or evidence as to why utility is deficient, but instead is reached only in other circumstances. However, since this analysis has been given considerable space in the Office Action, it will be addressed herein.

At the outset, it is submitted that the unpredictability (apparently of the art of chemistry as a whole) alleged at page 43 of the Office Action is in fact not supported by the breadth of the claim, as argued. It is important to note that a determination of undue experimentation must be considered on a *compound by compound* basis. The mere fact that a claim is broad does *not* mean that it is undue experimentation is required to determine enablement of the compounds therein, if it is not undue experimentation to determine enablement for *each* compound in the scope of the claim. See, for example, *In re Colianni*, 195 U.S.P.Q. 150 (CCPA 1977). One of ordinary skill in the art can easily determine, with the protocols given in the specification, whether a given prodrug has the utility stated. Thus, the mere fact that many compounds must be tested is not dispositive of lack of utility.

With respect to the guidance given by the instant specification, is submitted that the guidance is adequate, inasmuch as pharmaceutical formulation information is given, one of ordinary skill in the art can clearly prepare the compounds for administration, dosages are given and the pharmaceutical art is well developed as is the preparation of prodrugs. Administration of a prodrug for a given indication is quite routine. The discussion at pages 5-6 of the Office Action appears to be speculation on the part of the PTO that mechanisms are not well understood, however, elucidation of a mechanism is *not* necessary, where sufficient instruction is given to administer the compounds to

produce the desired effect. Thus, it is submitted that this is also a non-issue.

With respect to working examples, it is well established that working examples are *not* required to provide enablement. See, for example, *In re Borkowski*, 164 U.S.P.Q. 642 (CCPA 1970).

Finally, the focus at page 4 of the Office Action on "extensive and costly studies to determine safety and ethicacy" are of no concern to PTO, but rather are the providence of the FDA. This has no effect on enablement. See *In re Brana*, 51 F.3d 1560, 34 USPQ 1436 (Fed.Cir. 1995). Accordingly, it is submitted that prodrugs are fully enabled by the present specification. Withdrawal of this rejection is accordingly respectfully requested.

Claims 7 and 19 remain rejected under 35 U.S.C. 112, first paragraph. While it is now admitted that the specification enables methods of treating depression, it is argued that it does not provide enablement for any other disease. Applicants respectfully, albeit again quite strenuously, disagree.

First, in this regard, it is important to note, as a matter of law, that it is not necessary for Applicants' *method* claims to exclude inoperative embodiments, inasmuch as the claims are interpreted in light of the level of understanding one of ordinary skill in the art and, for methods, are interpreted to be *per se* functional. See *In re Angstadt*, 190 U.S.P.Q. 214 (CCPA 1976) and *In re Dinh-Nguyen*, 181 U.S.P.Q. 46 (CCPA 1974). These cases state that, for method claims, inoperative embodiments are not encompassed therein and the only questions is whether it would be undue experimentation for one of ordinary skill in the art to determine the scope of the claim.

In the previous reply, Applicants discussed at length how bioavailability determinations in the present specification, linked with particular receptary effect, enable determining, with only routine experimentation, whether the compounds are effective in treating a given disease. Moreover, in conjunction with the above-noted discussion of *In re Marzocchi*, it is not seen that even a single indication has been shown, with evidence, to be non-enabled. By contrast, Applicants have provided significant information establishing that the particular receptor effect of the compounds provides utility in treatment of a variety of indications claimed. However, the present Office Action refuses to consider this concrete evidence, arguing that it represents an "attempt to show the state of the art" and "cannot be properly used" because various documents are published after the filing date of the application. There are a variety of errors in this analysis.

First, the articles are not being provided to show "state of the art" but rather to show the voracity of the claims in the specification that treatment of the various indications claimed is enabled. It is well established that Applicant's filing date *can* be used to show that the disclosure is accurate. See, for example, *Enzo Biochem. Inc. v. Calgene, Inc.*, 188 F3d 1362, 52 USPQ 2d 1129 (Fed.Cir. 1988). Thus, the considerable evidence provided in the previous reply can be considered to show presumptively accurate the statement in the specification that the claims to treating the various indications are enabled. Withdrawal of the rejection is again respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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